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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,226	03/02/2004	Patrick Kappler	FR-AM1932 NP	3636

7590 01/26/2005

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EXAMINER
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HU, HENRY S

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/791,226

Applicant(s)

KAPPLER ET AL.

Examiner

Henry S. Hu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Oath & Declaration of 7-12-2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. It is noted that USPTO has received an Oath & Declaration filed on July 12, 2004.

**Claims 1-11** with two independent claims (**Claims 1 and 7**) are pending now. An action follows.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. **Claims 1-5**, drawn to a general process of making polyvinylidene fluoride (PVDF) homo- or co-polymer, classified in class 526, subclass 255.

II. **Claim 6**, drawn to a different process of making polyvinylidene fluoride (PVDF) homo- or co-polymer with specific steps in a batchwise or semi-continuous process, classified in class 526, subclass 225.

III. **Claims 7-11**, drawn to polyvinylidene fluoride (PVDF) homo- or co-polymer comprising sodium acetate, a potassium alkylsulphonate, a surface-active additive and with chain ends of  $-\text{CF}_2-\text{CH}_2-\text{O}-\text{SO}_3^-$ , classified in class 524, subclass 545.

Art Unit: 1713

3. The inventions are distinct, each from the others because of the following reasons:

**Inventions I and II** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention Group I was drawn to a general process of making polyvinylidene fluoride (PVDF) homo- or co-polymer, while Group II was drawn to a different process of making polyvinylidene fluoride (PVDF) homo- or co-polymer with specific steps in a batchwise or semi-continuous process, therefore the scope of the claims, i.e., the metes and boundaries are distinct. Although both inventions may contain the same fundamental four steps (a) – (d) as well as the same fundamental chemicals, **they are actually producing two different PVDF polymers** due to the presence or absence of other process steps or additive components. In addition to the fundamental four steps, it is noted that **each fundamental step in Group II requires having substep(s) along with other additive components**. With such a sophisticated process, **the PVDF polymer obtained from Group II will behave quite different from that of Group I.** The process of making is unique and thereby not interchangeable.

4. **Invention III** relates to a polyvinylidene fluoride (PVDF) homo- or co-polymer comprising sodium acetate, a potassium alkylsulphonate, a surface-active additive and with chain ends of  $-\text{CF}_2-\text{CH}_2-\text{O}-\text{SO}_3^-$ , while each of **inventions II and I** is related to a process or a methodology. It is noted that **such a specific polymer disclosed in Invention III may be one option of the polymers produced from Invention I or Invention II.** In most of the cases, different type of chain end may be obtained by using different component or step.

Art Unit: 1713

5. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. It is noted that one phone call was made to **Thomas F. Roland (tel: 215 419-7314)** on **December 17, 2004** by the examiner; a written letter was decided between examiner and attorney. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


### ***Conclusion***

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Henry S. Hu whose telephone number is **(571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

Art Unit: 1713


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry S. Hu

January 15, 2005



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SUPERVISORY PATENT EXAMINER  
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